

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed April 28, 2009. At the time of the Office Action, Claims 1-20 were pending in the Application and they stand rejected. Applicant amends certain Claims to expedite this prosecution. The amendments to the claims are not the result of any prior art reference and, thus, does not narrow the scope of the claim. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejection

Claims 1-9 are rejected as being unpatentable over U.S. Patent No. 7,277,957 issued to Rowley et al. (hereinafter "*Rowley*") and further in view of U.S. Patent No. 7,072,967 issued to Saulpaugh et al. (hereinafter "*Saulpaugh*"). Claims 10-11 are rejected as being unpatentable over *Rowley* and further in view of U.S. Patent No. 7,290,048 issued to Barnett et al. (hereinafter "*Barnett*"). Claims 12-20 are rejected as being unpatentable over *Rowley* in view of *Saulpaugh* and *Barnett*.

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. For example, Independent Claim 1, as amended, recites (*inter alia*) "...the packets

¹ See M.P.E.P. §2142-43.

representing a document that includes the objects, wherein the document is captured based on a capture rule that specifies the objects, and wherein a determination is made as to whether to discard or to store the objects of the document.” First, there is nothing in any of the cited references for ***the document being captured based on a capture rule that specifies the objects.*** There is simply no rule being applied, or any type of rule that specifies objects. Second, there is nothing in any of the cited references in which a determination is made for the aforementioned objects: much less a determination as to whether to discard or to store the objects of the document. Applicant has reviewed the cited references in their respective entirety and finds nothing that would be relevant to these features of Independent Claim 1. For at least these reasons, the Independent Claims are allowable over the cited reference. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

It is also worth noting that, even if all elements of the claims were disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

The U.S. Supreme Court's recent decision in *KSR Int'l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). The analysis regarding

an apparent reason to combine the known elements in the fashion claimed in the patent at issue “should be made explicit.” *KSR*, 127 S. Ct. at 1740-41. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the United States Patent and Trademark Office (“PTO”) in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO’s view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

For at least these reasons, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

No additional fees are believed due. However, please apply any other charges or credit any overpayment to Deposit Account No. 50-4889 of PATENT CAPITAL GROUP.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214-823-1241.

Respectfully submitted,

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